

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

The Examiner has required a new title. The title has been appropriately amended herein.

The abstract was objected to and has been appropriately amended herein to obviate the objection.

Claim 1 was objected to for informalities. Claim 1 has been appropriately amended herein.

Claims 5, 6 and 7 were objected to under 37 CFR 1.75(c) as being in improper multiple dependent form. Applicant respectfully submits that claims 5, 6 and 7 are proper multiple dependent claims. They do not depend from any multiple dependent claims and they refer to claims 1, 2, and 3 in the alternative. Therefore, Applicant respectfully requests that the objection be withdrawn and the claims treated on the merits.

Claims 1-4 and 8-22 were rejected under 35 U.S.C. 103(a) over Applicant's admitted prior art (AAPA) in view of U.S. Patent No. 5,999,349 to Choi. For the following reasons, the rejection is respectfully traversed.

Regarding claims 1 and 8-22, the Examiner acknowledges that AAPA does not teach a tap coefficient monitoring unit, as required. Thus, Choi is relied upon for teaching this limitation. Applicants submit that, there is nothing in the prior art that suggests modifying the teachings of AAPA to include the teachings of Choi. The Examiner states that by making the modification "the waveform equalizer has better performance while transfer path varies and improve multipath fading problems." The Examiner is respectfully reminded that a hindsight recognition of a benefit of making the modification or combination does not replace the existence of an actual suggestion in the prior art. Further, the Examiner is reminded that: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found *in the prior art*, not in applicant's disclosure."

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Reply to Office action of July 6, 2004

MPEP § 2143 (emphasis added) (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicants respectfully submit that, at the time the invention was made, there was no motivation or suggestion in the prior art to combine the references. As such, the present rejection relies upon an impermissible hindsight reconstruction of the present invention. Thus, no *prima facie* case of obviousness exists sufficient to maintain a rejection under 35 U.S.C. 103(a). If the Examiner intends to maintain the rejection, Applicants respectfully request that the Examiner indicate where a proper suggestion or motivation can be found in the prior art.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33152.

Respectfully submitted,

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